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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,230	04/19/1999	CHRISTOPHER EWING	3175.01A	6950

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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/295,230

Applicant(s)

EWING, CHRISTOPHER

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-133 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 129-132 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 3, 10, 22-27, 35, 42, 51-61, 67, 74, 83-93, 99, 106, 118-123 and 126-128 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims:

Claims rejected are 1,2,4-9,11-21,28-34,36-41,43-50,62-66,68-73,75-82,94-98,100-105,107-117,124,125 and 133.

DETAILED ACTION

1. Applicant's arguments of 12/12/06 have been considered, but are not convincing.

Further, applicant's arguments regarding the newly introduced term "devoid" are not convincing and are not supported by the specification, despite Professor Hollaar's opinion that "The importance of this limitation to the fundamental nature of the invention of the present application can be seen in the depth of teaching in the specification."

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 112

3. Claims 1 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As amended and argued, the word "devoid" is not supported by the specification, a word search was completed and the word "devoid" was not found.

Response to Arguments

4. Applicant argues that the Bezos reference does not state that it is devoid and this silence is not the same as an affirmative teaching of a devoid method. The Bezos reference teaches the entry of email address or telephone number which are seen to be pseudonymous names devoid of revealing the non-pseudonymous name as claimed.

The gift system of Bezos does not require a non-pseudonymous name of the recipient, an email address or telephone number (both pseudonymous identifiers) is sufficient, further investigation is performed by the system to identify the delivery address of the recipient, and is seen to be the operation of the system without revealing the non-pseudonymous name of the receiver to the giver.

The email contact of (501b) see paragraph (0022) reveals that the electronic mail, which is seen to be sent over the Internet, reveals a tracking number and information indicating that a gift is to be sent to the recipient, this is the only information given the recipient and is seen to be without revealing the non-pseudonymous name of the giver to the receiver. Even if the giver's email address were to be revealed to the receiver, the giver's email address it is seen to be a pseudonymous name that does not reveal the giver's non-pseudonymous name to the receiver.

5. Applicant argues that the 102 rejection is improper, but argues the newly added word "devoid" which was not required by the previous claims and is unsupported by the specification. Applicant further argues that the Bezos reference does not state that it is devoid and this silence is not the same as an affirmative teaching of a devoid method. The Bezos reference teaches the entry of email address or telephone number which are seen to be pseudonymous names devoid of revealing the non-pseudonymous name as claimed. Applicant further argues that it is improper to require Applicant to prove what was not in Bezos. Applicant was not asked to prove what was not in Bezos, but presented with the Examiner's interpretation of the reference and analysis of what was taught, telephone numbers and tracking numbers are pseudonymous identifiers that do not reveal non-pseudonymous names and email addresses do not necessarily have to reveal non-pseudonymous names.

6. Applicant's request to explain pursuant to Sec. 132 the combination in view of the Board's reasoning in *Ex parte Massey*, was not explained previously nor will it be explained in this action because the reference *Ex parte Massey* is not of record and could not be found in a search of the USPQ with the title provided, further the examiner is unsure what section 132 is a section of.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the claims to confirming purchases, and charging fees are seen to be old and well known in the business arts and the references Walker and Oneda are both in the business arts as is Bezos and are seen to be combinable.

7. Applicant's declaration has been considered but is not convincing because Professor Hollaar argues to the new matter term "devoid."

8. The claim objections of the previous action were not argued and the claims were not cancelled, therefore they are repeated below.

Claim Objections

9. Claims 9, 41, 73, 105 and 133 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

As per Claim 9. the parent claim 1, contains only the method for acceptance of the gift, there is no option for refusal, therefore the notification based on refusal of the gift is not seen to be an option and does not further modify the independent claim.

As per Claim 133. the parent claim 129, contains only the method for processing the sending of the gift, therefore the determining of whether the second party would accept the gift is not seen further modify the independent claim.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1-2, 4, 9, 11-14, 16, 19-21, 28-29, 30-34, 36-41, 43-50, 62--66, 68-73, 75-82, 94-98, 100-105, 107-117, 124-125 are rejected under 35 U.S.C. 102(e) as being anticipated by Bezos et al (US 2002/1078089).

As per Claim 1.

Bezos et al ('089) discloses:

receiving a request over the internet from a first party for a gift to be sent to a second party, see figure 4 and paragraph (0015), lines 5-8 and (0016);

obtaining over the Internet from said first party a pseudonym of said second party, see figure 5 (501a, 502a) and paragraph (0015) lines 8-14;

securing over the Internet a non-pseudonymous name and address associated with the second party's pseudonym, see figure 8 (801, 804, 805);

determining, over the internet, whether said second party would accept the gift, see figures 3, 5, 6 and (0019), if sufficient reply is received from the recipient via email from the email contact of (501b) or telephone contact of (502b) the second party has effectively agreed to accept the gift, if an email is sent (501b) and a sufficient reply is not received in the allotted time or if the telephone number is used (502b), and a message is left, see figures 5 and 6, if the recipient doesn't return the call to provide the delivery information, the recipient has effectively refused receipt of the gift; and

if said second party would accept that gift, processing said request to send said gift to produce computer output enabling said gift to be sent to said second party without revealing a non-pseudonymous name, see paragraph (0022) of one of said parties to another of said parties according to the request, see figure 8 (808).

As per Claim 2.

Bezos et al ('089) further discloses the step of issuing an order that said gift be sent to said second party's non-pseudonymous name and address, see figure 8 (809).

As per Claim 4.

Bezos et al ('089) further discloses contacting said second party and requesting revelation of said second party's non-pseudonymous name and address, see figure 5 (501b, 502b) and figure 3 (305).

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As per Claim 9.

Bezos et al ('089) further discloses informing the first party that the second party has not chosen to accept the blind gift, see figure 9 (905) and (0015) last 3 lines.

As per Claim 11, 28.

Bezos et al ('089) further discloses giving the first party an opportunity to reveal true identity information about said first party's self, see paragraph (0021) lines 21-23

As per Claim 12, 29.

Bezos et al ('089) further discloses giving the second party an opportunity to reveal true identity information about said second party's self, see figure 6 (603, 605).

As per Claim 13, 20.

Bezos et al ('089) further discloses electronically charging a fee, see paragraph (0021) line 21-22.

As per Claim 14.

Bezos et al ('089) further discloses electronically charging a fee to a charge card, see paragraph (0021) line 21-22.

As per Claim 16.

Bezos et al ('089) further discloses electronically charging a fee, see paragraph (0021) line 21-22.

As per Claim 19.

Bezos et al ('089) discloses:
a web site, enabling said first party to send a gift to a second party without revealing a non-pseudonymous name corresponding to said first party to said second party and without revealing a non-pseudonymous name of said second party to said first party, see paragraph (0016), lines 1-14 and paragraph (0022).

As per Claim 21, 32.

Bezos et al ('089) further discloses gift is sent only responsive to an acceptance communication from the second party, see figures 5 and 6, if the telephone number is used, and a message is left, see figures 5 and 6, if the recipient doesn't return the call to provide the delivery information, the recipient has effectively refused receipt of the gift.

As per Claim 30.

Bezos et al ('089) further discloses gift is sent responsive to a message from the second party, see figure 6 (603).

As per Claim 31.

Bezos et al ('089) further discloses gift is sent responsive to an acceptance communication from the second party, see figure 6 (606).

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As per Claim 33-34, 36-41, 43-50, 62-64.

Bezos et al ('089) further discloses the step of processing said request to send a gift is carried out without revealing the non-pseudonymous name of said first party to said second party, and without revealing a non-pseudonymous name of said second party to said first party, see paragraph (0022) specifically lines 9-18 (the second party is given the tracking number of the gift order, not the first party's non-pseudonymous name) and paragraphs (0015) and (0017) (the first party enters only the email address or phone number of the second party and databases or contact by the service gather the information from the second party).

As per Claim 65-66, 68-73, 75-82, 94-96.

Bezos et al ('089) further discloses the step of processing said request to send a gift is carried out without revealing the non-pseudonymous name of said first party to said second party, see paragraph (0022) specifically lines 9-18 (the second party is given the tracking number of the gift order, not the first party's non-pseudonymous name).

As per Claim 97-98, 100-105, 107-114.

Bezos et al ('089) further discloses the step of processing said request to send a gift is carried out without revealing the non-pseudonymous name of said second party to said first party, see paragraphs (0025) and (0017) (the first party enters only the email address or phone number of the second party and databases or contact by the service gather the information from the second party).

As per Claim 115-117, 124-125.

Bezos et al ('089) further discloses the website determines whether said second party would accept said gift prior to said enabling said first party to send said gift, , see figures 5 and 6, if the telephone number is used, and a message is left, see figures 5 and 6, if the recipient doesn't return the call to provide the delivery information, the recipient has effectively refused receipt of the gift.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claim 15 is rejected under 35 U.S.C. 103(a) as obvious over Bezos (089) in view of Walker (6,330,544).

As per Claim 15.

Bezos et al ('089) further discloses electronically charging a fee to a charge card, see paragraph (0021) line 21-22.

Bezos et al ('089) does not disclose the step of confirming receipt of said order that said blind gift be sent, before electronically charging said fee to said first party.

Walker (6,330,544) teaches charging after confirmation of receipt of a gift, see column 3, lines 31-35 for the benefit of greater flexibility in gift giving

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Bezos ('089) to confirm receipt of said order that said gift be sent, before electronically charging said fee for the benefit of greater flexibility in gift giving.

12. Claims 17, 18 are rejected under 35 U.S.C. 103(a) as obvious over Bezos (089) in view of Oneda (5,965,860).

As per Claim 17.

Bezos et al ('089) further discloses electronically charging a fee related to the value of the gift, see paragraph (0021) lines 21-22.

Bezos et al ('089) does not disclose the step of charging another fee.

Oneda ('860) teaches a membership management system that charges a membership fee, see column 6, lines 3-10 for the benefit of recovering operating costs.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Bezos ('089) to register members and charge a membership fee to recover operating costs.

As per Claim 18.

Bezos et al ('089) further discloses electronically charging a fee related to the value of the gift, see paragraph (0021) lines 21-22.

Bezos et al ('089) does not disclose the step of charging a fee to the second party.

Oneda ('860) teaches a membership management system that charges a membership fee, see column 6, lines 3-10 for the benefit of recovering operating costs.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Bezos ('089) to register members and charge a membership fee to recover operating costs.

Not disclosed by Prior Art

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13. Claims 3, 10, 22-27, 35, 42, 51-61, 67, 74, 83-93, 99, 106, 118-123 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As per Claim 3.

Bezos et al ('089) further discloses securing said second party's non-pseudonymous name and address by looking up in a database, see figure 8 (802, 803) and figure 3 (305), but does not disclose the database is a network membership database.

As per Claim 10.

Bezos et al ('089) further discloses contacting a third party for sending of a gift, see paragraph (0003) (the postal service), but does not disclose electronically contacting a third party to send the gift.

As per Claim 22.

Bezos et al ('089) does not disclose the website enables said second party to refuse a gift from said first party if said first party is not identified by a particular name.

As per Claim 23.

Bezos et al ('089) does not disclose the website enables said second party to refuse a gift from said first party if said first party is not identified by a true name.

As per Claim 24.

Bezos et al ('089) does not disclose the website enables said second party to refuse a blind gift from said first party if said first party is identified by a particular pseudonym or true name.

As per Claim 25.

Bezos et al ('089) does not disclose the website enables said second party to refuse a blind gift from said first party if said blind gift is of a particular type.

As per Claim 26.

Bezos et al ('089) does not disclose the website enables said second party to respond to said first party after delivery of a blind gift sent to said second party by said first party.

As per Claim 27.

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Bezos et al ('089) does not disclose the website enables said second party to respond to said first party after refusal of an attempted blind gift to said second party by said first party.

As per Claim 51-61. 126-128.

Bezos et al ('089) does not disclose the website enables a request to send said gift by accessing a membership database containing said non-pseudonymous name of said first party and said non-pseudonymous name of said second party.

14. Claims 129-132 are allowed.

As per Claim 129.

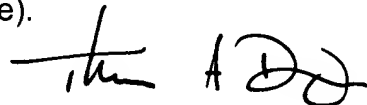
The prior art of record, Bezos et al ('089), further discloses securing said second party's non-pseudonymous name and address by looking up in a database, see figure 8 (802, 803) and figure 3 (305), but does not disclose the database is a network membership database.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner
Art Unit 3639

March 07